

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

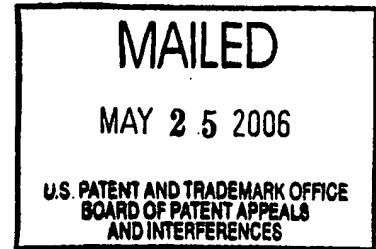
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID STANTON, MARK POTTS, SAMEER VAIDYA,
and MARK PERREIRA

Appeal No. 2006-0928
Application No. 09/616,330

ON BRIEF



Before BARRY, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 13-36, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

BACKGROUND

The invention relates to a messaging platform that facilitates communication between different computers. When a request is serialized and encoded into a platform-independent language such as XML, the encoded message is transmitted over the Internet using an HTTP protocol to a receiving computer. The receiving computer validates the message and delivers it to the component providing the requesting service. (Abstract.) Claim 13 is reproduced below.

13. A messaging platform for a component-based software system, the platform comprising:

- a connection assembler for at least one of creating, managing and manipulating a first messaging platform connection;

- a protocol management framework for implementation of a predetermined transport protocol over the first messaging platform connection;

- a schema generator for, responsive to a request for service received over a second messaging platform connection, creating a document according to a predetermined format, the document containing information to be provided to another system over the first messaging platform connection;

- an encoding component for converting a document in the predetermined format into a first encoded object that can be understood and used by the other system, the first encoded object being encoded according to a default encoding protocol; and

- a translation component for encoding a document in the predetermined format into a second encoded object that can be understood and used by the other system, the second encoded object being encoded according to an encoding protocol different from the default encoding protocol.

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The examiner relies on the following references:

Young	US 6,560,606 B1	May 6, 2003 (filed May 4, 1999)
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Kumar et al. (Kumar)	US 6,542,515 B1	Apr. 1, 2003 (filed May 19, 1999)
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Ankireddipally et al. (Ankireddipally)	US 6,772,216 B1	Aug. 3, 2004 (filed May 19, 2000)
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Don Box et al. (Box), Simple Object Access Protocol (SOAP) 1.1, W3C Note 08, May 2000, available at <http://www.w3.org/TR/2000/NOTE-SOAP-20000508/> (Jul. 9, 2004).

Claims 13-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kumar and Box.

Claims 22-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ankireddipally and Young.

We refer to the Final Rejection (mailed Mar. 16, 2005) and the Examiner's Answer (mailed Oct. 28, 2005) for a statement of the examiner's position and to the Brief (filed Aug. 15, 2005) for appellants' position with respect to the claims which stand rejected.

OPINION

Rejections over the prior art

To demonstrate the obviousness of the subject matter of instant claim 13, the examiner proposes combining the teachings of Kumar and Box. Kumar does not "expressly" teach an encoding component for converting a document in the

predetermined format into a first encoded object that can be understood and used by another system, the first encoded object being encoded according to a default encoding protocol. The rejection turns to Box for the teaching. The examiner concludes that the subject matter of claim 13 would have been obvious since a default protocol such as SOAP defines a simple mechanism for expressing application semantics by providing a modular packaging model and encoding mechanisms for encoding data within modules. (Answer at 3-4.)

Appellants submit that Kumar discloses a combination of XML document type definition (DTD) documents transmitted via HTTP, and an adapter to unpack stacked request messages in the XML DTD for use in an Application Programming Interface (API). Box, however, states under the heading "3. Relation to XML," that "[a] SOAP message MUST NOT contain a Document Type Declaration." Appellants argue that, accordingly, there is no reason or suggestion to combine the references as proposed by the rejection.¹ (Brief at 4-6.)

The examiner's response (Answer at 10-11) is that Box later states in section 3 that with the exception of two named attributes, "it is generally permissible to have attributes and their values appear in XML instances or alternatively in schemas, with equal effect. That is, declaration in a DTD or schema with a default or fixed value is

¹ Contrary to appellants' implication, Kumar states that "[a] request set is defined by an XML data type description (DTD)." Col. 14, ll. 63-64 (emphasis added). In any event, the examiner does not contend that the DTD described by Kumar is something different from the Document Type Declaration discussed in Box.

semantically equivalent to appearance in an instance.” Appellants, on the other hand, submit the following position.

With respect, Applicant disagrees. The cited portion of Box states that declaration in a DTD or schema with a default or fixed value is semantically equivalent to appearance in an instance. The cited portion of Box DOES NOT state that DTD can be used in a SOAP message, but rather that a SOAP message MUST NOT contain a DTD. Semantic equivalence in a programming language does not mean that the syntax required to implement the feature will be accepted by a compiler for the programming language or that it will not generate a runtime error upon execution, however. Accordingly, the syntax for a DTD is not interchangeable with the syntax for an XML schema or instance, despite semantic equivalence.

(Brief at 6.)

The examiner might have responded with argument or evidence in support of why appellants’ position should be deemed erroneous or irrelevant. However, we find no response at all from the examiner. In view of the unequivocal statement in Box that a SOAP message “MUST NOT” contain a Document Type Declaration, we are constrained to agree with appellants that a prima facie case for obviousness has not been established for instant claim 13. We therefore do not sustain the rejection of claim 13, nor of depending claims 14 through 21.

Nor can we sustain the § 103 rejection of claim 22, or of claims 23 through 36 incorporating the limitations of base claim 22. We agree with appellants that several features of claim 22 are not described or suggested by the applied art. For example, the rejection contends that Ankireddipally discloses creating an object upon receipt of a service request, and transmitting “the object and the request document to a system hosting the service component,” referring to column 15, lines 12 through 32 and column

18, lines 10 through 23. (Answer at 6.) The column 15 (Fig. 2) section speaks of transmission of XML documents and DOM (Document Object Module) objects. The column 18 section refers to Figure 6, and discusses transmission of Request and Reply messages. The rejection deems Young to teach an encoder object, and transmitting the encoder object and a request document at column 6, lines 46 through 67 and Figure 1B. The column 6 section describes transmitting encoded object streams, rather than transmitting an encoder object.

In any event, there is no convincing rationale as to why one would wish to transmit an encoder object and a request document in a system such as that described by Ankireddipally or Young. We further address the limitations of instant claim 22 in a new ground of rejection, set forth infra.

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 22-36 are rejected under 35 U.S.C. § 112, first paragraph, for lack of written description.

Appellants submit, in the Brief's "Summary of Claimed Subject Matter," that instant claim 26 is described, at least in part, in "Application Appendix I." (Brief at 3.) The instant specification (at 27) purports that material contained in "Appendix I" is "incorporated herein by reference."

However, essential material may not be incorporated by reference to a non-patent publication. See Manual of Patent Examining Procedure (MPEP) § 608.01(p), under heading “I. INCORPORATION BY REFERENCE,” 7th Ed., Rev. 1, Feb. 2000, which was effective at the time of filing of the instant application (Jul. 15, 2000). An improper incorporation by reference may be remedied. See id. at heading I.A.2, “Improper Incorporation.” See also MPEP § 608.01(p), “I. INCORPORATION BY REFERENCE,” 8th Ed., Rev. 3, Aug. 2005.

Even if we were to assume that the material relied upon by appellants was present in the specification, however, we would not find claim-supporting disclosure for the subject matter of claims 22 through 36.

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Compliance with the written description requirement is essentially a fact-based inquiry that will necessarily vary depending on the nature of the invention claimed. Enzo Biochem v. Gen-Probe, Inc., 323 F.3d 956, 963, 63 USPQ2d 1609, 1612 (Fed. Cir. 2002) (citations omitted).

The invention claimed does not have to be described in ipso verbis in order to satisfy the written description requirement. Union Oil Co. v. Atlantic Richfield Co., 208

F.3d 989, 1000, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000). However, one skilled in the art, reading the original disclosure, must be able to immediately discern the limitations now claimed. See Waldemar Link GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994) ("The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.").

One shows "possession" by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Id.

Appellants' "Summary of Claimed Subject Matter" in the Brief does not purport to point out where the various requirements of dependent claims 23 through 36 may be found in the disclosure (or appendix). We note that the relevant rule does not require reference to the specification for dependent claims that are not separately argued. See 37 CFR § 41.37(c)(1)(v).

In any event, we find the "Summary" in the Brief to be unhelpful with respect to showing written description support for independent claim 22, even with a presumption that the appendix is part of the specification. Appellants refer to "Application Appendix I, page 22, Part One: Item 2" as support for the claimed "create an encoder object upon

receipt of the service request,” and to “page 23, Part Two: Item 2” of the appendix as support for “wherein the encoder object identifies a handler.”

As summarized at page 22 of the appendix, the relevant section describes the process whereby a sender invokes a recipient's method. The sender creates an XML document and sends it to the Request Processor. The Request Processor repackages the XML document and sends it to the recipient. The recipient's return values are packaged and sent back to the sender. Page 22, Part One, Item 2 relates that the sender creates an Encoder object, which identifies the type of encoding required by the recipient. Page 23, Part Two, Item 2 relates that the Request Processor identifies the name of the `RuntimeRequestHandler` to be used for the request.

What is claimed, however, are logic instructions operable to, inter alia, “receive a service request from a sender” and “create an encoder object upon receipt of the service request, wherein the encoder object identifies a handler that translates the request document to a document format required by the service component.” The sender as described in the appendix cannot “create an encoder object upon receipt of the service request,” because the sender originates, rather than receives, the service request. Further, according to the claim, the encoder object identifies the handler. As described in the appendix, the Request Processor identifies the handler.

Appellants do not attempt to point out where the final step of claim 22 -- “transmit the encoder object and the request document to a system hosting the service component” -- may be described. While the request (XML) document as described is

sent from the sender to the Request Processor (e.g., appendix at page 23; Fig. 7) and from the Request Processor to the recipient (e.g., appendix at page 24; Fig. 8), we find no description of transmitting an encoder object to the recipient (or system hosting the service component).

CONCLUSION

The rejection of claims 13-36 under 35 U.S.C. § 103 is reversed.

A new rejection of claims 22-36 under 35 U.S.C. § 112, first paragraph is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED -- 37 CFR § 41.50(b)

~~LANCE LEONARD BARRY~~
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

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